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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,760	06/07/2001	Markus Scheuber	34183/233887	2221

826 7590 04/16/2004

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EXAMINER

CULLER, JILL E

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/876,760

Applicant(s)

SCHEUBER ET AL.

Examiner

Jill E. Culler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/078914.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5, 7-8, 10-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,681,348 to Mowry, Jr. in view of U.S. Patent No. 4,983,990 to Fröhlich.

Mowry, Jr. shows a method of providing text on a printed surface, 20, of a printed product, 10, comprising the steps of applying a partially transparent contrast panel, 40, to the printed surface by printing the contrast panel onto the printed surface, with the contrast panel allowing the printed surface of the printed product, 20, to be seen therethrough, see Fig. 3, and forming information within or on the contrast panel, with the contrast panel forming a contrast with respect to the information so that the information can be easily seen and read, wherein the step of forming information within or on the contrast panel comprises forming blank areas within the contrast panel, with the blank areas forming the information. See column 1, lines 49-55 and Fig. 3 in particular.

Mowry, Jr. does not teach providing text on each of a plurality of printed products by conveying the printed products along a path of travel in an overlapping imbricated

stream such that a border region of each printed product is exposed by the imbricated overlap as each printed product passes printing stations along the path of travel.

Fröhlich teaches providing text on each of a plurality of printed products by conveying the printed products along a path of travel in an overlapping imbricated stream, see column 2, lines 55-59, such that a border region of each printed product is exposed by the imbricated overlap as each printed product passes printing stations along the path of travel. See column 3, lines 55-57.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the printing steps of Mowry, Jr. with the printing method of Fröhlich in order to provide text on the borders of a plurality of printed articles in an efficient, automated manner.

3. Claims 6, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mowry, Jr. in view of Fröhlich as applied to claims 5, 7-8, 10-11 and 13 above, and further in view of Gurwick.

Mowry Jr. and Fröhlich teach all that is claimed, as in the above rejection of claims 5, 7-8, 10-11 and 13, except that the step of forming information within or on the contrast panel comprises printing the information onto the contrast panel.

Gurwick teaches a method of forming information, 18, within or on a contrast panel, 16, by printing the information onto the contrast panel. See page 3, lines 9-21.

It would have been obvious to one having ordinary skill in the art at the time of the invention to form information on the contrast panel of Mowry, Jr., as combined with

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Fröhlich by printing the information, as taught by Gurwick, in order to provide additional contrast between the panel and the information.

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mowry, Jr. in view of Fröhlich as applied to claims 5, 7-8, 10-11 and 13 above, and further in view of U.S. Patent No. 4,538,161 to Reist.

Mowry, Jr. and Fröhlich teach all that is claimed, as in the above rejection of claims 5, 7-8, 10-11 and 13 except that the conveyor system comprises a plurality of clamps arranged one behind the other in the conveying direction for gripping respective ones of the printed products.

Reist teaches a conveyor system, 11, comprising a plurality of clamps, 13, arranged one behind the other in the conveying direction for gripping respective ones of printed products.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the conveyor system of Reist with the invention of Mowry, Jr. and Fröhlich in order to move the printed products through the printing process in a well-controlled manner.

5. Claims 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over "A Century of Comics", (as discussed in the article entitled "1933: The First Comic Book" by Mike Benton) in view of U.S. Patent No. 4,983,990 to Fröhlich.

The first paragraph of the article describes the comic books as “four-color, tabloid-sized” magazines. These magazines would therefore have been produced using a four-color printing process, as discussed in the enclosed article “Understanding Color” by John C. Lee.

Using this information, it can be seen that “A Century of Comics” shows a method of providing text on a printed surface of a printed product, consider the first layer of colored printing for the balloon in the cover illustration, comprising the steps of applying a partially transparent contrast panel to the printed surface by printing the contrast panel onto the printed surface, with the contrast panel allowing the printed surface of the printed product to be seen therethrough, consider the second layer of color printing for the balloon, using partially transparent ink so that the original layer of printing can be seen through the second layer, and forming information within or on the contrast panel, with the contrast panel forming a contrast with respect to the information so that the information can be easily seen and read, consider the text on the surface of the balloon, wherein the step of forming information within or on the contrast panel comprises printing the information onto the contrast panel.

“A Century of Comics” does not teach providing text on each of a plurality of printed products by conveying the printed products along a path of travel in an overlapping imbricated stream such that a border region of each printed product is exposed by the imbricated overlap as each printed product passes printing stations along the path of travel.

Fröhlich teaches providing text on each of a plurality of printed products by conveying the printed products along a path of travel in an overlapping imbricated stream, see column 2, lines 55-59, such that a border region of each printed product is exposed by the imbricated overlap as each printed product passes printing stations along the path of travel. See column 3, lines 55-57.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the printing method of "A Century of Comics" with the printing method of Fröhlich in order to provide text on the borders of a plurality of printed articles in an efficient, automated manner.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over "A Century of Comics" in view of Fröhlich as applied to claims 5-13 above, and further in view of U.S. Patent No. 4,538,161 to Reist.

"A Century of Comics" and Fröhlich teach all that is claimed, as in the above rejection of claims 5-13 except that the conveyor system comprises a plurality of clamps arranged one behind the other in the conveying direction for gripping respective ones of the printed products.

Reist teaches a conveyor system, 11, comprising a plurality of clamps, 13, arranged one behind the other in the conveying direction for gripping respective ones of printed products.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the conveyor system of Reist with the method of "A Century of

Comics", as modified by Fröhlich in order to move the printed products through the printing process in a well-controlled manner.

Response to Arguments

7. In response to applicant's argument that the patent to Mowry is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the patent of Mowry and the applicant's invention are both in the field of printing, and are directed toward the problem of printing information in more than one layer, therefore the teachings of Mowry are relevant to applicant's invention.

In response to applicant's argument that there is no suggestion to combine the Mowry and Fröhlich references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, because Fröhlich teaches that it is advantageous to convey documents in an imbricated manner, one having ordinary skill in the art would recognize this advantage to a variety of types of documents, such as those disclosed by Mowry.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). "A Century of Comics" has been used to teach only portions of the claims, as stated in the above rejections, and has been combined with other references for the teaching of applicant's claimed subject matter. Also, although the documents discussed in "A Century of Comics" differ from those disclosed by applicant, the claims, as broadly interpreted by the examiner, are taught by the reference.

Conclusion

8. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill E. Culler whose telephone number is (571) 272-2159. The examiner can normally be reached on M-Th 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jec


Dan Colilla
Primary Examiner
Art Unit 2854